

§Appl. No. 09/997,267  
Amdt. dated January 19, 2006  
Reply to Office Action of, October 19, 2005

## **REMARKS**

### **Claim objections**

The reference to the “SEQ ID” numbers has been corrected as suggested.

### **Rejection under §101**

The claims have been amended to indicate that the claimed nucleic acids are “isolated.” See, e.g., Specification, Page 5, lines 19-21.

Claim 15 has been amended to conform the claims to U.S. practice. Support for the amendment can be found through the specification, e.g., on Page 8, lines 3-21.

### **Rejection under §112, second paragraph**

The original application is an English translation of a German document, and such translation differences appear to have resulted in certain language and grammatical references that the examiner believes are unclear. The claims have been amended to clarify the intended meaning of the claims.

Claim 1 and others have been amended to indicate that the claimed nucleic acid codes for an “androgen-binding receptor” to distinguish it from the already known androgen receptor. See, Specification, Page 1, second paragraph. The former is also referred to as AR32 and AR42. See, e.g., Specification, Paragraph spanning Pages 2-3. The specification clearly describes the claimed nucleic acids as coding for polypeptides which bind to androgens and which modulate their activity. See, e.g., Specification, Paragraph spanning Pages 3-4; Page 18, Fig. 4B. The claims have accordingly been amended to recite such activities. See, e.g., Claims 1 and 27.

Several of the claims were rejected as lacking antecedent basis for the phrase “nucleic acid,” “vector,” or “cell.” The basis for these rejections is not understood since the claims at issue

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clearly recited the phrase in the claim to which the dependent claim referred. Nonetheless, it is believed that the claim amendments clarify all claims, and eliminate any indefiniteness.

**Rejection under §112, first paragraph (Pages 6-12)**

The claims have been amended to recite specific hybridization wash conditions and to indicate that the claimed nucleic acids possess the recited biological activity. This format was stated by the Patent Office to conform to the requirements of §112, first paragraph. See, *Synopsis of Written Description Guidelines*, Example 9; *Enzo Biochem. Inc. v. Gen-Probe Inc.*, 63 USPQ2d 1609 (Fed. Cir. 2002). The recited hybridization wash conditions yield structurally similar sequences. Furthermore, Applicant has disclosed two species (e.g., AR32 and AR42) that fall within the scope of the claim. Consequently, it is believed that the claimed subject is enabled and that the specification reasonably conveys to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

The specification clearly describes the activity of the claimed “androgen receptor” that distinguishes it from the already known androgen receptor. Claims are not read in vacuum, but in the context of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Therefore, it would be unreasonable to construe the claim terms to read on the already known androgen receptor, since the latter is clearly distinguished in the specification. See, e.g., Specification, Page 1, second paragraph; Pages 3-4.

**Rejection under §102(b)**

Applicant respectfully traverses the rejection of the claims as allegedly anticipated by Zamencnik, WO 97/11170.

The cited reference does not describe a nucleic acid that codes for an androgen-binding receptor that modulates the activity of the androgen receptor. Compare amended Claim 1. Moreover, the reference does not describe a polypeptide which comprises the amino sequence set

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forth in SEQ ID NO:6 (compare Claims 2 and 3) or which acts as a transrepressor for the androgen receptor (compare Claim 27). Thus, WO 97/11170 fails to teach all elements of the claimed subject matter, and therefore cannot anticipate it.

The claims have also been amended to indicate that the claimed nucleic acids are "isolated." The latter would have been understood in the context of the specification. Thus, the claims are not anticipated by the disclosure of the chromosome disclosed in U.S. Pat. No. 5,508,164.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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